

PATENT
Attorney Docket No. **CW-06719**

R E M A R K S

Claims 22, 25-27 and 29-41 are currently pending. In the Office Action mailed March 15, 2004, the Examiner has raised two rejections:

- 1) Claims 22, 25-27 and 29-38 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Tao (U.S. Patent No. 6,284,007); and
- 2) Claims 39-41 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Tao (U.S. Patent No. 6,284,007) in view of Tsaras (U.S. Patent No. 3,844,706).

1) The Claims Are Unobvious in View of Tao

The Examiner has rejected Claims 22, 25-27 and 29-38 under 35 U.S.C. §103(a), as allegedly unpatentable over Tao ('007 Patent). The Examiner states:

"Tao differs from the claims in that he does not specifically teach the claimed iodine value. However, it would be reasonable to expect that the triglycerides and fatty acids of Tao would possess the claimed iodine value because Tao teaches that the triglycerides are fully hydrogenated and that he prefers triglycerides and free fatty acids that are saturated" (of record).

"Applicant argues that an iodine value of 5 or less is not an inherent property of a composition comprising a fully hydrogenate triglyceride. This argument is also submitted in the declaration of Jerry Bertrand. The Examiner recognizes that other factors play into how an iodine value of 5 or less is obtained. As pointed out in Mr. Bertand's declaration, purity of the fatty material is one of the determining factors. However, Tao takes this factor into consideration because he teaches at col 2, lines 57-59 that subsequent additional purification may be perform[ed] on the triglycerides. He follows this teaching with the statement that the triglycerides may be fully hydrogenated. These teachings taken together suggest that the triglycerides of Tao possess the claimed iodine values. Applicant argues that Tao teaches the acceptability of using unsaturated fatty acid components. The examiner agrees. However at col. 3, lines 1-3 Tao teaches that he prefers to use saturated free fatty acids" (Office Action, pages 2 and 3).

Applicant must respectfully disagree that the teachings of Tao taken together suggest that Tao's candle compositions "comprised of a vegetable lipid component and a petroleum wax" ('007 Patent, abstract) have an IV less than 5, and when burned substantially no soot is produced.

PATENT
Attorney Docket No. **CW-06719**

Applicant argues that the Examiner is essentially making an inherency argument in stating that "it would be reasonable to expect that the triglycerides and fatty acids of Tao would possess the claimed iodine value", as the text cited by the Examiner does not state that such properties are found in the Tao candle. The courts have found that "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."¹ In addition, the court has held that an unstated element must exist as a matter of scientific fact, in order to be found inherent.² As evidenced by the Declaration of Jerry Bertrand submitted with the previous response to office action, the final iodine value of a hydrogenated fatty material varies depending upon the catalyst employed, and the temperature of the reaction, in addition to the factors (purity and saturation) addressed by Tao. Thus, low iodine values and in particular **iodine values of less than 1 or less than 0.5** (as recited in Claims 26, 29, 32-38 and 41) cannot be considered to be an inherent property of the compositions of Tao cited by the Examiner.

In addition Applicant argues that Tao does not explicitly or implicitly teach candle compositions that when burned, produce substantially no soot. In fact, the only teaching provided by Tao in this matter is the statement that "soot and smoke formation was subjectively judged to be lower when candles including a vegetable lipid-based composition were burned compared to paraffin wax-based candles under the same conditions" ('007 Patent, at column 5, lines 35-39). Thus, Tao simply provides candle compositions that produce less soot than a very sooty (paraffin) candle, which does not equate with the claimed candle producing substantially **no soot** (e.g., "less than" a high amount may still be a high amount).

Finally, although some of the elements of the claimed invention are disclosed by Tao (e.g., candle comprising hydrogenated plant source triglycerides), Tao fails to teach or suggest the *specific combinations* recited in the claims. In particular, Tao does not disclose a candle comprising plant source triglycerides and a non-plant source free fatty acid, that together possess an iodine value of less than 5, and that when burned substantially no soot is produced. Thus, Applicant respectfully requests that this rejection be withdrawn.

¹ *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981).

² *Hughes Aircraft Co. v. U.S.*, 8 USPQ2d 1580, 1583 (Cl. Ct. 1988).

PATENT
Attorney Docket No. CW-06719

2) The Claims Are Unobvious in View of the Combination of Tao and Tsaras

The Examiner has rejected Claims 39-41 under 35 U.S.C. §103(a), as allegedly unpatentable over Tao ('007 Patent) in view of Tsaras ('706 Patent). Like Tao, the Tsaras patent also fails to teach or suggest candle compositions comprising plant source triglycerides, and a non-plant source free fatty acid, that together possess an iodine value of less than 5, and that when burned substantially no soot is produced. Thus, Applicant respectfully requests that this rejection be withdrawn.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect.

Dated: July 14, 2004



Christine A. Lekutis
Registration No. 51,934

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
415.904.6500